

Atty. Docket No. JP920000104US1
(590.056)

REMARKS

Please note the fact that July 3, 2005, fell on a Sunday ensures that this paper is timely filed as of today, Tuesday, July 5, 2005 (the next succeeding day which is not a Saturday, Sunday, or Federal Holiday).

Before addressing the outstanding Office Action, Applicant again notes the prior Office Action refers to the first two Information Disclosure Statements submitted by Applicant and indicates the Office has considered the references cited therein. Both the prior Office Action and the outstanding Office Action are silent about the Second Supplemental Information Disclosure Statement submitted by Applicant on May 25, 2004. A copy of the stamped post-card acknowledging receipt of same by the Office was previously submitted by Applicant. Applicant again respectfully requests that the Examiner review the file to determine if this submission is contained therein and, if so, consider the reference cited therein. If not, the Examiner is invited to contact the undersigned by telephone and the undersigned will provide another copy of the submission to the Office.

In the Office Action dated May 3, 2005, pending Claims 1-18 were rejected and the rejection made final. Claims 1, 4, 9, 12, and 14-18 are independent claims; the remaining claims are dependent claims. In response Applicant has filed herewith an Amendment After Final, has amended independent Claims 1, 4, 9, and 14-18, and has cancelled dependent Claim 3. Applicant intends no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in

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acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 12-13 stand rejected under 35 U.S.C. § 102(e) as being anticipated Matsumoto (hereinafter "Matsumoto"). Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 12 recites, *inter alia*, a process for accepting a request from a remote user to generate voice synthesis data for a speaker selected by the remote user, as well as a process for, in accordance with the request, **generating and outputting a transaction number**. Additionally, claim 12 recites a process for, **upon the receipt of the transaction number, outputting voice synthesis data that are consonant with the request**. (emphasis added) It is respectfully submitted that Matsumoto clearly falls short of the present invention (as defined by independent claim 12) in that, *inter alia*, it does not disclose generating voice synthesis data for a speaker selected by the remote user. With regards to this rejection in the outstanding office action, it was stated that "Matsumoto teaches a speech synthesis system using a voice characteristic chosen by a user as agreed by the applicant in third paragraph, page 10 of the remark section." (page 2, item 1) However, there is no section of the prior amendment, dated December 2004,

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which contained such a statement, or any statement of agreement upon such a contention. In fact, the action explicitly takes the stance on page 7, paragraph 3 that "Matsumoto fails to disclose that the request from a remote user includes a speaker selected by the remote user."

Additionally, it is respectfully submitted that Matsumoto clearly falls short of present invention (as defined by independent claim 12 and the other independent claims of the present invention) in that, *inter alia*, it also does not disclose generating and outputting a transaction number in accordance with receiving data, nor does it disclose, upon the receipt of the transaction number, outputting voice synthesis data that are consonant with the request. In the outstanding Office Action, the schedule information that is stored in the system is referred to as the transaction number. However, this schedule data is not generated upon receipt of the text data submitted by the user, nor is it submitted by the user in order to have the voice synthesis data transmitted. Accordingly, Applicant respectfully submits that the applied art does not anticipate the present invention because, at the very least, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); *see also In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

Claims 1-4, 7, 9 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto and in view of Kiraly et al. (hereinafter "Kiraly"). Claims 5 and 10-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

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Matsumoto in view of Kiraly and in further view of Ladd et al. (hereinafter "Ladd").

Reconsideration and withdrawal of the present rejections is hereby respectfully requested.

Initially, Applicant respectfully asserts that neither Kiraly nor Ladd is properly considered prior art with respect to the present case. Both of these applied references issued as United States Patents subsequent to the June 26, 2001, filing in the United States (and the June 26, 2000, filing in Japan) of the present application. As such, it is respectfully submitted neither Kiraly nor Ladd is properly considered prior art with respect to the present case. In any event, however, the present invention is not obvious over the combinations of Matsumoto and Kiraly or Matsumoto, Kiraly and Ladd.

The present invention generally relates to voice synthesis for enabling a transaction via a network of voice synthesis data which are obtained by synthesizing the voice of a specific character. (Page 1, lines 7-9)

As best understood, Matsumoto is directed to a speech synthesis system used in connection with a schedule managing system to vocally output the content of the schedule. (Col. 2, lines 8-13) There is no teaching or suggestion the vocal output is in a voice of a specific character chosen by a user of the scheduling managing system.

As best understood, Kiraly is directed to a computer system which simultaneously displays text information and synthesizes speech signals representative of the text being displayed in order to reinforce via multiple media channels the information being presented. (Col. 2, lines 23-50) It appears as if the speech synthesis may be selected from preset voices having different characteristics. For example, "a document may have

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embedded in it an indicator that identifies to the text-reader software the document is a horror story. Then, the text-reader software ... will automatically adjust the voice parameters accordingly to fit the mood of the horror story (e.g. voice volume, pitch, inflection, speed, etc.)". (Col. 13, lines 25-32) Certain pre-determined voice parameters may be stored with common names (e.g., "Bill" or "Jane") to assist in identifying and selecting the parameter set. There is not teaching or suggestion, however, that these common names are associated with voice parameters that correspond to a specific individual (or character) as in the present invention.

As best understood, Ladd is directed to a markup language to provide interactive services. (Abstract) Apparently, a user of the language of Ladd may be charged for retrieving certain information. As the Office admits, however, there is no teaching or suggestion that any voice synthesis in Ladd is in a voice of a specific character chosen by a user.

The instantly claimed invention requires specifically "wherein the server of the service provider assigns a transaction number to the customer; and wherein, when the transaction number is presented by the terminal of the customer, the server transmits the voice synthesis data to the terminal of the customer". (Claim 1) Similar language appears in the other independent claims. Assigning a transaction number to the request data and having the customer use that transaction number in order to have the voice synthesis data transmitted is simply not taught or suggested by either Matsumoto, Kiraly, or Ladd.

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Moreover, combining the teachings of the Matsumoto, Kiraly, and Ladd patents would not result in the instantly claimed invention. If these teachings were combined, a schedule managing system would vocally output the content of the schedule using a voice whose parameters would change based upon perceived "mood" of the scheduled item (i.e., dinner with the in-laws – horror) and the user of the system would be charged for the vocalization of a scheduled item. Thus, following the teachings of Matsumoto, Kiraly, and Ladd would not result in the claimed invention which includes assigning a transaction number to the request data and having the customer use that transaction number in order to have the voice synthesis data transmitted. The applied references simply do not teach or disclose this, either alone or in combination.

While the outstanding rejections are based on a combination of Matsumoto, Kiraly, and Ladd, nearly twenty years ago, the Court of Appeals for the Federal Circuit recognized the importance of the individual references in characterizing the holding of *In re Imperato*, 179 USPQ 730 (C.C.P.A. 1973), as follows:

The lesson of this case appears to be that prior art referenced in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.

Again, in *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed. Cir. 1984), the Court stated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of reference can be combined **only** if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive.

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Accordingly, we hold the Court below erred as a matter of law in concluding the claimed invention would have been obvious to one of ordinary skill in the art under section 103.

These Federal Circuit teachings are especially cogent here given the combination of Matsumoto, Kiraly, or Ladd fails to teach or suggest the instantly claimed invention.

In view of the foregoing, it is respectfully submitted that Claims 1, 4, 9, 12, and 14-18 are fully distinguishable over the applied art and are thus allowable. By virtue of dependence from Claims 1 and 4, it is thus also submitted that Claims 2-3, 5-8, and 10-11 are also allowable at this juncture. Applicant acknowledges that Claim 8 was indicated by the Examiner as being allowable if rewritten in independent form. Applicant reserves the right to file a new claim of such scope at a later date that would still, at that point, presumably be allowable.

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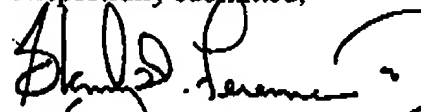
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In summary, it is respectfully submitted that the instant application, including Claims 1-18, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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